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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,396	09/24/2001	Stephen McCann	3036/50289	5628

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EXAMINER
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WILLIAMS, JEFFERY L

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/960,396	<b>Applicant(s)</b> MCCANN ET AL.	
	<b>Examiner</b> Jeffery Williams	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

This action is in response to the communication filed on 8/16/2005.

All objections and rejections not set forth below have been withdrawn.

***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 1, as amended, includes the limitation of a “mobile telephone with a valid cellular mobile account” (line 6). The specification provides support for a *user* possessing a valid cellular mobile account. However, the specification does not provide support for the requirement of a specific device, *a mobile telephone* possessing a valid cellular mobile account (see Specification, page 5, line 16 – page 6, line 2). It is evident, in the first case, that a user who possesses a valid cellular mobile account may employ a mobile device in general. In the second case, as amended, the user must specifically employ a mobile telephone that possesses a valid cellular mobile account. This fact is supported by the Applicant’s own admission stating, “Applicants note that it is clear from the specification of the present application that the term “user” refers to an individual who is the owner of a mobile telephone and

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1 *has a mobile telephone account. (See, for example, page 3, lines 1- 16; page 4, line 15*  
2 *- page 5, line 2; page 6, lines 3-9; and page 9, lines 15-18.)*" ("Remarks", 8/16/05, page  
3 12).

4  
5 ***Claim Rejections - 35 USC § 112***

6  
7 The following is a quotation of the first paragraph of 35 U.S.C. 112:

8 The specification shall contain a written description of the invention, and of the manner and process of  
9 making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the  
10 art to which it pertains, or with which it is most nearly connected, to make and use the same and shall  
11 set forth the best mode contemplated by the inventor of carrying out his invention.  
12

13 Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with  
14 the written description requirement. The claim(s) contains subject matter which was not  
15 described in the specification in such a way as to reasonably convey to one skilled in  
16 the relevant art that the inventor(s), at the time the application was filed, had possession  
17 of the claimed invention. See objection to specification above.

18  
19  
20 ***Claim Rejections - 35 USC § 103***

21  
22 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for  
23 all obviousness rejections set forth in this Office action:

24 (a) A patent may not be obtained though the invention is not identically disclosed or described as set  
25 forth in section 102 of this title, if the differences between the subject matter sought to be patented and  
26 the prior art are such that the subject matter as a whole would have been obvious at the time the  
27 invention was made to a person having ordinary skill in the art to which said subject matter pertains.  
28 Patentability shall not be negated by the manner in which the invention was made.

1  
2       **Claims 1 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over**  
3       **Turunen, “Mobile internet access”, EP 0 944 203 A2 in view of Salo et al., “Data**  
4       **Center for Providing Subscriber Access to Data Maintained on an Enterprise**  
5       **Network”, U.S. Patent 6,563,800 B1 and in view of Mouly et al., “GSM System for**  
6       **mobile communications”.**

7  
8       Regarding claim 1, Turunen discloses an access authentication system for  
9       authenticating access to a first wireless local area network (W-LAN), the operator of  
10      which administers a visitor authentication, authorization and accounting (VAAA) server:

11       *wherein a user requesting visiting access to the first W-LAN, and having a mobile*  
12      *telephone with a valid cellular mobile account, a portable computing device with a*  
13      *browser and a registration with a second W-LAN operator that administers a home*  
14      *authentication, authorization and accounting (HAAA) server, conveys to the VAAA*  
15      *server, by user intervention, identity information sufficient to enable said VAAA server to*  
16      *communicate with said HAAA server so as to authenticate the proposed connection*

17      (Turunen, fig. 3). Turunen discloses the user having a cellular account and a portable  
18      computing device connected to a mobile phone, the arrangement allowing the user to  
19      use the phone for internet access (Turunen, col. 1, lines 34-49). Seeking internet  
20      access while on a foreign network, the user registers with the FA (“VAAA”) server,  
21      which in turn, provides communication to the HA (“HAAA”) server (Turunen, fig. 3; col.  
22      2, lines 28-43). Registration includes the sending of authentication information from the  
23      mobile user to the FA server to the HA server (Turunen, col. 3, lines 50-58);

1        *said HAAA issuing a personal identification number (PIN) which is encoded and*  
2        *forwarded to the user's mobile telephone* (Turunen, col. 5, lines 37-45; col. 6, lines 45-  
3        56). The authentication key ("PIN") is sent via the GSM SMS and is therefore encoded.

4  
5        Turunen does not disclose that the PIN is *transferred to the browser to*  
6        *authenticate the requested visiting access to the W-LAN*. Salo et al., however,  
7        discloses that a user with a computing device and browser authenticates himself to a  
8        network by supplying a PIN to a browser (Salo et al., col. 9, lines 4-17). It would have  
9        been obvious to one of ordinary skill in the art to combine the method disclosed by Salo  
10       et al. for transferring a PIN to a browser for network authentication with the system of  
11       Turunen, because transferring authentication information via a browser to a server  
12       would enable one to gain network access.

13  
14       The combination of Turunen and Salo et al. does not disclose *the cost of such*  
15       *access being billed to the user's cellular mobile account and the requested access*  
16       *being achieved via the user's browser*. However, it is obvious that management  
17       standards for GSM networks would be incorporated in systems that utilize the GSM  
18       network. Thus, a user employing the GSM network for internet access would be billed  
19       for the services he consumes, and that the billing would be applied to the account he  
20       uses to obtain such services. Mouly et al., demonstrates this obvious by showing that it  
21       is standardized GSM management procedure for the subscription of a GSM account  
22       holder, who uses the services of foreign networks, be billed for such use (Mouly et al.,

1 pg. 435, par. 2; pg. 439, pars. 4,5). It would have been obvious to one of ordinary skill  
2 in the art to use the standard GSM management procedures, including the disclosed  
3 billing method, of Mouly et al. with the combination of Turunen and Salo et al., because  
4 it is obvious that a GSM subscriber would have the costs for the services he uses billed  
5 to his account.

6  
7 Regarding claim 2 the combination of Turunen, Salo et al., and Mouly discloses:  
8 *wherein the transfer of the PIN to the browser is effected manually by the user* (Salo et  
9 al., col. 9, lines 4-17).

10  
11 Regarding claim 3 the combination of Turunen, Salo et al., and Mouly does not  
12 disclose *wherein the portable computing device is coupled to the mobile telephone and*  
13 *the transfer of the PIN to the browser is effected automatically by means including*  
14 *software supported by the portable computing device.* However, it would have been  
15 obvious to one of ordinary skill in the art, based upon legal precedent, to have the PIN  
16 transferred to the browser automatically using appropriate means for such automation  
17 because it is obvious to provide an automatic means as replacement to a manual  
18 means (In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

19  
20 Regarding claim 4 the combination of Turunen, Salo et al., and Mouly discloses:

1 *wherein the PIN issued by the HAAA is encoded and forwarded to the user's mobile*  
2 *telephone by means of a short message service centre* (Turunen, col. 4, lines 41-50;  
3 col. 6, lines 51-56).

4  
5       Regarding claim 5 the combination of Turunen, Salo et al., and Mouly discloses:  
6 *wherein the user employs the browser to convey said identity information, via the first*  
7 *W-LAN, to the VAAA* (Turunen, col. 3, lines 50-55; Salo et al., col. 9, lines 4-17),.

8  
9       Regarding claim 6 the combination of Turunen, Salo et al., and Mouly discloses:  
10 *wherein the PIN is combined with masking information* (Turunen, col. 5, lines 37-  
11 45; col. 6, lines 45-56). The authentication key ("PIN") is sent via the GSM SMS and is  
12 therefore encoded ("combined with masking information").

13  
14       Regarding claim 7, the combination of Turunen, Salo et al., and Mouly discloses:  
15 *wherein said masking information is randomly derived* (Mouly et al., pg. 483, fig.  
16 7.9). As disclosed, GSM encryption is derived from random elements, and thus, the  
17 masking information is randomly derived.

18  
19       Regarding claim 8, the combination of Turunen, Salo et al., and Mouly discloses:  
20 *wherein the user calls the VAAA on the mobile telephone* (Turunen, figs. 3, 4). The  
21 mobile user communicates with the FA through a mobile telephone.

22



Regarding claim 9, the combination of Turunen, Salo et al., and Mouly discloses: *wherein the telephone call from said user is routed to the HAAA through a premium rate call unit* (Turunen, figs. 3, col. 6, lines 38-58). The combination of Turunen, Salo et al., and Mouly discloses that calls are carried over the GSM network, through the HA and FA units, and are charged a premium.

***Response to Arguments***

Applicant's arguments filed 8/16/2005 have been fully considered but they are not persuasive.

Applicant argues primarily that:

(i) *First, Turunen does not disclose a step of conveying an identity information by user intervention. Rather, because the object of a roaming procedure is a seamless handover, a user intervention would not be acceptable in the teaching of Turunen, in order to achieve this object.* ("Remarks", 8/16/05, page 11).

In response, the examiner respectfully asserts that the mobile host of Turunen is "mobile", not in the manner that it is self-transporting, but rather, in the manner that it is used by a user, and by user intervention, is transported and employed within foreign networks chosen by the user. Therefore, the applicant's arguments that the prior art fails to show "user intervention" is unpersuasive.

1           (ii) *Furthermore, Turunen also fails to teach or suggest conveying identity*  
2 *information in order to enable the visitor server to communicate with the home server.*  
3 *("Remarks", 8/16/05, page 12).*

4           In response, the examiner respectfully directs the applicant's attention to the  
5 rejection of claim 1. For purposes of additional clarification, the examiner points to  
6 Turunen (col. 1, lines 25-28; par. 5; col. 2, lines 35-52; pars. 12, 30, 31, 33). Turunen  
7 discloses that a mobile host, with a fixed address, needs to have communication  
8 destined for its home network transmitted to its assigned address in the foreign network.  
9 This communication, between a foreign network and home network, is accomplished via  
10 a registration. This registration includes the sending of identity information (including  
11 address information and authentication information).

12  
13           (iii) *Turunen does not disclose that this PIN is used for authenticating access to*  
14 *the foreign network as provided in the present invention ("Remarks", 8/16/05, page 13).*

15           In response, as shown above the above rejection and responses, Turunen  
16 discloses accessing a foreign network in order to use the internet. This proposed  
17 connection to the internet using the foreign network is authenticated with a PIN  
18 (Turunen, par. 1).

19  
20           (iv) *However, it is an essential feature of the present invention according to Claim*  
21 *1 that the access to the visited W-LAN is billed to the user's cellular mobile account.*  
22 *That is, the access to a first network (visited W-LAN) is billed to an account of a second*

1 *network (GSM network) which is different from the first network* ("Remarks", 8/16/05,  
2 *page 14).*

3 *Turunen does not disclose a billing of access costs to an account which is*  
4 *different from the "home" account* ("Remarks", 8/16/05, page 14).

5 In response to applicant's argument that the references fail to show certain  
6 features of applicant's invention, it is noted that the features upon which applicant relies  
7 (i.e., *access to a first network (visited W-LAN) is billed to an account of a second*  
8 *network (GSM network) which is different from the first network*) are not recited in the  
9 rejected claim(s). Although the claims are interpreted in light of the specification,  
10 limitations from the specification are not read into the claims. See *In re Van Geuns*, 988  
11 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12  
13  
14 **Conclusion**

15  
16 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time  
17 policy as set forth in 37 CFR 1.136(a).

18 A shortened statutory period for reply to this final action is set to expire THREE  
19 MONTHS from the mailing date of this action. In the event a first reply is filed within  
20 TWO MONTHS of the mailing date of this final action and the advisory action is not  
21 mailed until after the end of the THREE-MONTH shortened statutory period, then the  
22 shortened statutory period will expire on the date the advisory action is mailed, and any

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1 extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of  
2 the advisory action. In no event, however, will the statutory period for reply expire later  
3 than SIX MONTHS from the mailing date of this final action.

4 Any inquiry concerning this communication or earlier communications from the  
5 examiner should be directed to Jeffery Williams whose telephone number is (571) 272-  
6 7965. The examiner can normally be reached on 8:30-5:00.

7 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
8 supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone  
9 number for the organization where this application or proceeding is assigned is 571-  
10 273-8300.

11 Information regarding the status of an application may be obtained from the  
12 Patent Application Information Retrieval (PAIR) system. Status information for  
13 published applications may be obtained from either Private PAIR or Public PAIR.  
14 Status information for unpublished applications is available through Private PAIR only.  
15 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should  
16 you have questions on access to the Private PAIR system, contact the Electronic  
17 Business Center (EBC) at 866-217-9197 (toll-free).

18  
19  
20 Jeffery Williams  
21 Assistant Examiner  
22 Art Unit 2137

  
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